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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,087	09/13/2004	Hideaki Nisogi	KOD158B.001APC	7686

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EXAMINER	
FORTUNA, JOSE A	

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/500,087	NISOGI ET AL.	
	Examiner	Art Unit	
	José A. Fortuna	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/24/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,929,845. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the claims is the calendering of the paper and the claimed density of said paper; however, calendering gravure printing paper is conventional in the art and thus, it, the coating of the gravure paper, would have been obvious to one of ordinary skill in the art. As to the density of the paper, this property is inherent to the papers of the US Patent and within the

density range of known coated papers for gravure printing. Note that the US patent discloses the same calendering lineal pressure range and the same method of making the papers, which indicates that the paper made by the method of claims 10-14 would necessary be the same as the ones of the US patent.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 4-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8, of copending Application No. 10/381,228. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims is the coating and the density of the papers included in the copending application; however, as indicated above coating and calendering the paper to be used in a gravure printing process is conventional in the art, thus it would have been obvious to one of ordinary skill in the art. As to the density of the papers, the

claimed density range is also within the levels of known papers substrates used in gravure printing.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dessauner, US Patent No. 4,867,844 or Authorn et al., US Patent No. 4,908,240 or Maholtra et al., US Patent No. 5,302,249 or Husband, EPO 860547 A2.

All of the above patents, Dessauner, Authorn et al., Maholtra et al., and Husband, teach a paper capable of being printed using the gravure printing process, in which said paper is treated with a binding inhibiting agent, same as the one disclosed and claimed in 5 and 6. They teach the coating and the calendering of the papers using similar calendering lineal pressures. They also teach the use similar pigments and binders for the coating of the sheet. Even though they are silent with regard to the density/bulk of the paper, this property seems to inherent to their papers, since they use the same process, same raw materials to make same/similar type of papers. Note that the decrease in the tensile is also inherent to their papers since it is result of using softeners/debonding agents and since they are used in the same addition range this property must also be

inherent to their sheet, see Maholtra et al., abstract and column 9, line 58 through column 11, line 13, (for the use of the same types of inhibiting agents), column 8, line 50 through column 9, line 2, column 9, lines 14-40 and column 18, lines 25-37 (for the use of fillers and pigments), column 6, lines 52-59 (for the coating) and example XIV in column 24, lines 26-55, (for the calendering); Dessauner; abstract and column 4, lines 18-21 and examples, see example 1 for the calendering operation, note the use of benzyl ammonium chloride, a debonding agent, in the examples; Authorn et al., abstract, column 2, line 22 through column 3, line 51, (note the use of imidazolines, a known debonding agent in the pulp); Husband, abstract, page 2, line 16 through page 3, line 42 and examples. It seems that all of the above patents/publications have all the limitations of the claims or at least the minor modification, e.g., the density and lineal pressure range, would have been obvious to one of ordinary skill in the art.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koji et al., JP Publication No. 2000-345493 or Koji et al., JP Patent Publication 11-279988 or Yoshihiko et al., JP Patent Publication No. 07-126999 in view of Tadakoro et al., EP 1 001 082 A1 or Tadakoro et al., EP 1 016 755 A2.

All of the primary references teach a dullish/matte-coated paper comprising a coating containing pigments, usually kaolin, which is then calendered to desire smoothness and/or density, see abstracts. The primary references teach also the use an adhesive, a binder, into the base paper and they teach that the papers have low density, which implies high bulk, since the density is the reciprocal of bulk, i.e., $Bulk = \frac{1}{\rho}$. Therefore, low density, i.e., high bulk is a desired feature of the coated papers of the primary references. The primary references do not explicitly teach the use fiber binding inhibiting agents. However, the secondary references, Tadakoro et al., teach paper bulking agents, same as claimed, to improve printability and voluminousness in coated,

calendered papers, see abstracts and paragraph [0002] of the EP'082 and abstract and paragraphs [0002] through [0005] of the EP'755. Therefore, using the bulking agents suggested by the secondary references, EP'082 and EP'755, would have been obvious to one of ordinary skill in the art in order to improve the bulk of the papers, which as taught by the primary reference is a desired property of their papers.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Dull Coated Printing Paper and Method of Making it."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

José A Fortuna
Primary Examiner
Art Unit 1731

JAF